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09/944,424	08/30/2001	Ichiro Futamura	09792909-5127	1855

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EXAMINER

REVAK, CHRISTOPHER A

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/944,424

Applicant(s)

FUTAMURA ET AL.

Examiner

Christopher A. Revak

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 14-21 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims currently recite of software alone and of itself that is non-statutory since it is not tangibly embodied. The examiner suggests storing the method and program on a computer readable medium.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of copending Application No. 09/944,192. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-24 of the instant application are envisioned by copending Application No. 09/944,192 in that claims 1-40 of copending Application No. 09/944,192 contains all the limitations of the instant application. Claims 1-24 of the instant application therefore are not patentably distinct from copending Application No. 09/944,192 claims, and as such, is unpatentable for obvious-type doubling patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 09/944,192. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-24 of the instant application are envisioned by copending Application No. 09/943,893 in that claims 1-28 of copending Application No. 09/943,893 contains all the limitations of the instant application. Claims 1-24 of the instant application therefore are not patentably distinct from copending Application No. 09/943,893 claims, and as such, is unpatentable for obvious-type doubling patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/943,858. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-24 of the instant application are envisioned by copending Application No. 09/943,858 in that claims 1-29 of copending Application No. 09/943,858 contains all the limitations of the instant application. Claims 1-24 of the instant application therefore are not patentably distinct from copending Application No. 09/943,858 claims, and as such, is unpatentable for obvious-type doubling patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 09/943,683. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-24 of the instant application are envisioned by copending Application No. 09/943,683 in that claims 1-30 of copending Application No. 09/943,683 contains all the limitations of the instant application. Claims 1-24 of the instant application therefore are not patentably distinct from copending Application No. 09/943,683 claims, and as such, is unpatentable for obvious-type doubling patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Dulude et al, U.S. Patent 6,310,966.

As per claims 1,13,22, and 24, Dulude et al discloses of method, system, and computer program embodied on a computer readable medium for executing personal authentication by comparing templates with sampling information input by a user. The templates being personal identification data acquired beforehand. A personal identification certificate authority generates and issues a person identification certificate having data items in accordance with a predetermined format and stores template information including the templates. An entity acquires the person identification certificate and executes a person authentication process on the basis of the templates of the acquired person identification certificate (column 3, lines 32-43 and column 4, lines 55-65).

As per claims 2 and 14, it is taught by Dulude et al that the person identification certificate issued by the personal identification certificate authority includes a digital signature added by the personal identification certificate authority (column 4, lines 55-65; column 6, lines 13-18; and as shown in Figure 2, item #22).

As per claims 3 and 15, Dulude et al teaches of the person identification certificate issued by the person identification certificate authority includes, as indispensable data, an identifier capable of identifying the person identification certificate and the identification data of the person to be authenticated on the basis of the person identification certificate (column 4, lines 19-25 and Figure 2, items # 18 and #20).

As per claims 4 and 16, the teachings of Dulude et al disclose of encrypting the template information using a public key of the personal identification certificate authority and stored in the person identification certificate to be generated by the personal identification certificate authority (column 4, lines 55-65; column 6, lines 2--8; and Figure 2, Issuer Name).

As per claim 5, Dulude et al discloses of encrypting template information using a public key of the entity and stored in the person identification certificate to be generated by the personal identification certificate authority (column 4, lines 55-65; column 6, lines 2-8; and Figure 2).

As per claims 6 and 17, it is taught by Dulude et al of encrypting template information using a common key and storing in the person identification certificate to be generated by the identification certificate authority. The common key being, encrypted

using a public key of the entity and stored in the person identification certificate (column 4, lines 55-65; column 6, lines 2-8; and Figure 2).

As per claims 7 and 18, it is disclosed by Dulude et al of encrypting template information and storing encryption algorithm information in the generated person identification certificate by the personal identification certificate authority (column 4, lines 55-65; column 6, lines 2-8; and Figure 2).

As per claims 8 and 19, Dulude et al discloses that the person identification certificate generated by the personal identification certificate authority stores personal information of the person to be authenticated (column 3, lines 32-43; column 4, lines 55-65; column 6, lines 2-8; and Figure 2).

As per claims 9 and 20, Dulude et al teaches of the person identification certificate generated by the personal identification certificate authority stores a public key certificate information of the person to be authenticated, identification data of a public key certificate of the person to be authenticated (column 3, lines 32-43; column 4, lines 55-65; column 6, lines 2-8; and Figure 2).

As per claims 10 and 21, Dulude et al discloses of the person identification certificate generated by the personal identification certificate authority stores link information linked to a public key certificate used in data communication or data processing which is executed on a condition that the personal authentication is successfully executed on the basis of the person identification certificate (column 4, lines 55-65; column 6, lines 2-8; and Figure 2).



As per claim 11, the teachings of Dulude et al disclose of the template storing fingerprint information, retina pattern information, iris pattern information, and voice print information (column 4, lines 27-30).

As per claim 12, Dulude et al discloses of an entity service provider makes a deal with a user who has been identified on the basis of the person identification certificate. A user device accessed by a user who has been identified on the basis of the person identification certificate, or the person identification certificate authority (column 4, lines 55-60 and Figure 2, Issuer Name and Issuer ID).

As per claim 23, it is disclosed in the teachings of Dulude et al of encryption processing means for decrypting encrypted templates stored in the person identification certificate (column 6, line 66 through column 7, line 19).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Matyas, Jr. et al, U.S. Patent 6,697,947 discloses of using biometrics to authenticate multiple parties.

Bisbee et al, U.S. Patent 6,367,013 discloses using public keys with biometric information and certificates.

Musgrave et al, U.S. Patent 6,202,151 discloses of the use of biometric certificates.

Dulude et al, WO 98/50875 discloses of the use of biometric certificates.


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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CR

  
June 20, 2005

Christopher Revak  
AU 2131

  
6/20/05